



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/511,544

08/19/2005

Yoshikazu Nakayama

4468-057

2304

22429

7590

05/11/2009

LOWE HAUPTMAN HAM & BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

EXAMINER

DOLE, TIMOTHY J

ART UNIT

PAPER NUMBER

2831

MAIL DATE

DELIVERY MODE

05/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,544	Applicant(s) NAKAYAMA ET AL.	
	Examiner TIMOTHY J. DOLE	Art Unit 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,13,14,20-26,42 and 43 is/are rejected.
- 7) ☒ Claim(s) 3-12,15-19,27-41,44 and 45 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/18/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. Figures 20-23 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Art Unit: 2831

The abstract contains the legal phraseology “means” on lines 3, 6 and 7, which should be avoided.

Claim Objections

3. Claims 2, 5, 9, 18-20, 24-26, 28, 29, 32, 35, 36 and 39-45 are objected to because of the following informalities: in claim 2, line 4, the period after the word “said” should be removed; in claim 5, line 6, the dash before the word “a” at the end of the line should be removed; in claim 5, line 10, the word “Occurrence” should not be capitalized; in claim 9, line 10 “arid” should be “and”; in claim 9, line 20, the period after the word “said” should be removed; in claim 18, there should be a period at the end of the claim; in claim 19, line 18 the apostrophe after the word “said” should be removed; in claim 20, line 1, “the computer” lacks antecedent basis; in claim 20, line 8, the period after the word “said” should be removed; in claim 24, line 3, the period after the word “said” should be removed; in claim 25, line 13, “pa” should be “parameter”; in claim 26, line 2, “the computer” lacks antecedent basis; in claim 26, lines 6 and 8, the period after the word “said” should be removed; in claim 26, there should be a period at the end of the claim; in claim 28, lines 3 and 7, the period after the word “said” should be removed; in claim 29, line 14, the dash before the word “the” should be removed; in claim 32, line 10, the period after the word “and” should be removed; in claim 35, line 4, the period after the word “said” should be removed; in claim 36, lines 26 and 29-30 “the signal source” lacks antecedent basis; in claim 39, line 3, the period after the word “and” should be removed; in claim 40, line 8, “(c)” should be “(d)”; in claim 41, lines 2-3, 29-30 and 33-34, “the signal source” lacks antecedent basis; in claim 41, line 3, “said input signal” lacks antecedent basis; in claim 41, line 22, the

Art Unit: 2831

period after the word “predetermined” should be removed; in claim 42, line 1, “the computer” lacks antecedent basis; in claim 43, line 1, “the computer” lacks antecedent basis; in claim 43, lines 3, 29-30 and 33-34, “the signal source” lacks antecedent basis; in claim 43, lines 3-4, “said input signal” lacks antecedent basis; in claim 43, line 23, “(e-“ should be “(e-4)”; in claim 44, line 2, “the computer” lacks antecedent basis; in claim 45, line 2, “the computer” lacks antecedent basis; and in claim 45, line 6, the period after the word “and” should be removed.

Also note that there may be additional typographical errors in the claims that have not specifically been pointed out, so a thorough proofreading of the claims is suggested. Appropriate correction is required.

4. Claims 2-13, 15-19, 21-25, 27-31, 33-35 and 37-39 are objected to as being dependent upon a rejected and/or objected base claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-25, 42 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are drawn to a computer program per se. A computer program per se is abstract instructions. Therefore, a computer program is not a physical thing (product) nor a process as they are not “acts” being performed. As such, these claims are not directed to one of the statutory categories of invention (See MPEP 2106.01), but are directed to nonstatutory functional descriptive material.

Art Unit: 2831

It is noted that computer programs embodied on a computer readable medium or other structure, which would permit the functionality of the program to be realized, would be directed to a product and be within a statutory category of invention, so long as the computer readable medium is not disclosed as non-statutory subject matter per se (signals or carrier waves).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 2831

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 13, 14 and 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 11, 14 and 16 of U.S. Patent No. 7,302,351. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the claims of the patent.

Allowable Subject Matter

8. The claims would be allowable if rewritten or amended to overcome the rejection(s) and objections set forth in this Office action.

9. The following is a statement of reasons for the indication of allowable subject matter: the claims are considered to contain allowable subject matter due to the inclusion of claim limitations: “a signal output acquiring element for acquiring the predetermined parameter concerning said input signal after the occurrence of the measurement system error factors; and a measurement system error factor acquiring element for acquiring the measurement system error factors based on the measurement results of said input signal measuring element, said reflected signal measuring element and said signal output acquiring element” in each of the independent claims.

Conclusion

Art Unit: 2831

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY J. DOLE whose telephone number is (571)272-2229.

The examiner can normally be reached on Mon. thru Fri. from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy J. Dole/
Primary Examiner, Art Unit 2831